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APPLICATION NO.	FI	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/733,752		12/08/2000	Gaines W. Hammond	BSC-181	4800	
21323	7590	07/12/2002				
TESTA, H	JRWITZ	& THIBEAULT	EXAMINER			
HIGH STRE	TREET		PELLEGRINO, BRIAN E			
BOSTON, N	1A 02110	Ü		ART UNIT	PAPER NUMBER	
				3738		
				DATE MAILED: 07/12/2002	DATE MAILED: 07/12/2002	

Please find below and/or attached an Office communication concerning this application or proceeding.

			LA college (In)				
ů .		Application No.	Applicant(s)				
		09/733,752	HAMMOND ET AL.				
Office Action Summary		Examiner	Art Unit				
		Brian E Pellegrino	3738				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply							
THE N - Extension - Extension - If the I - Failure - Any re	DRTENED STATUTORY PERIOD FOR REPLY MAILING DATE OF THIS COMMUNICATION. sions of time may be available under the provisions of 37 CFR 1.1 SIX (6) MONTHS from the mailing date of this communication. period for reply specified above is less than thirty (30) days, a reply period for reply is specified above, the maximum statutory period of the reply within the set or extended period for reply will, by statute eply received by the Office later than three months after the mailing dipatent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be ti y within the statutory minimum of thirty (30) da will apply and will expire SIX (6) MONTHS fron cause the application to become ABANDON!	mely filed ys will be considered timely. n the mailing date of this communication. ED (35 U.S.C. § 133).				
1)⊠	Responsive to communication(s) filed on 12/8	<u>8/00</u> .					
2a) <u></u> □	This action is <b>FINAL</b> . 2b)⊠ Th	is action is non-final.					
3)	Since this application is in condition for allows	ance except for formal matters, p	prosecution as to the merits is				
closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. <b>Disposition of Claims</b>							
4)⊠	Claim(s) 1-19 is/are pending in the application	١.					
4a) Of the above claim(s) is/are withdrawn from consideration.							
5)	Claim(s) is/are allowed.						
6)[	6) Claim(s) is/are rejected.						
7)	Claim(s) is/are objected to.						
8) Claim(s) 1-19 are subject to restriction and/or election requirement.							
Application Papers							
9) The specification is objected to by the Examiner.							
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.							
If approved, corrected drawings are required in reply to this Office action.							
12) The oath or declaration is objected to by the Examiner.							
i .	under 35 U.S.C. §§ 119 and 120						
1	Acknowledgment is made of a claim for foreig	n priority under 35 U.S.C. § 119	(a)-(d) or (f).				
· ·	a) ☐ All b) ☐ Some * c) ☐ None of:						
, í	1. Certified copies of the priority documents have been received.						
	2. Certified copies of the priority documents have been received in Application No						
<ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>							
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).							
a) ☐ The translation of the foreign language provisional application has been received.  15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.							
Attachme	nt(s)	_	•				
2) Noti	ce of References Cited (PTO-892) ce of Draftsperson's Patent Drawing Review (PTO-948) rmation Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Inform	ary (PTO-413) Paper No(s) al Patent Application (PTO-152)				
U.S. Patent and	Trademark Office						

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#### **DETAILED ACTION**

#### Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-9, drawn to a prostatic stent, classified in class 623, subclass
   23.66.
- II. Claims 10-19, drawn to a catheter-stent system and method, classified in class 623, subclass 1.11.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the stent-catheter system does not require a retaining member. The subcombination has separate utility such as being delivered or implanted via an inflatable balloon instead of using a releasably coupled connecting segment to deliver the stent.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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This application contains claims directed to the following patentably distinct species of the claimed invention:

## Prostatic stents and retaining devices

Species I: Fig. 3.

Species IV: Fig. 6.

Species II: Fig. 4.

Species V: Figs. 10-12.

Species III: Fig. 5.

Species VI: Fig. 17.

Species VII: Fig. 26 (distal end of stent w/ retaining device)

Species VIII: Fig. 27 (distal end of stent w/ retaining device)

Species IX: Fig. 28 (distal end of stent w/ retaining device)

### Stent-catheter systems

→ Species A: Figs. 1,2.

Species B: Fig. 16.

### Pushing rod

- Species 1) Fig.7.
- Species 2) Fig. 8.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from <u>each</u> group of species listed for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

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is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino July 10, 2002

prin & Pllaymo

Bruce Snow

**Primary Examiner**